

## REMARKS

Reconsideration of the above-identified application in view of the foregoing amendments and following arguments is respectfully requested.

Claims 17, 22, 23 and 25-30 have been amended. Claims 31-35 have been added. Claims 23, 26, 27 and 30 were amended simply to correct the dependency of these claims. Claims 28 and 29 were amended to correct typographical errors.

### Drawings

The Examiner stated that the application contained color photographs and these photographs would only be accepted if the conditions for accepting color drawings had been satisfied. Applicant herewith encloses a Petition requesting the acceptance of such colored drawings.

### Status of the Application

Applicant wishes to thank the Examiner for catching that the last amendment contained 2 claims numbered "20" and for re-numbering the claims. Applicant has amended the dependent claims to reflect this revised numbering.

### Claim Rejections – 35 U.S.C. Section 112, First Paragraph

Claims 17, 22, 23 and 25-30 were rejected under 35 U.S.C. Section 112, first paragraph as not being described in the specification in such a way to reasonably convey to one skilled in the art that at the time the application was filed that the inventor had possession of the invention. Applicant respectfully traverses this rejection.

The inquiry into whether the description requirement is met is determined on a case-by-case basis and is a question of fact. Section 2163.04 *Manual of Patent Examining Procedure* (8<sup>th</sup> Edition, August 2001). When a question regarding the adequacy of the written description arises, the fundamental factual inquiry is whether the

specification conveys to those skilled in the art, as of the filing date sought, that Applicant was in possession of the invention being claimed. Section 2163.02 *Manual of Patent Examining Procedure* (8<sup>th</sup> Edition, August 2001). Possession can be shown in a number of ways. For example, an Applicant can show possession by: (1) an actual reduction to practice of the claimed invention; (2) a clear depiction of the invention in detailed drawings or in structural chemical formulas which permit a person skilled in the art to clearly recognize that applicant had possession of the claimed invention; or (3) any description of sufficient, relevant, identifying characteristics so long as a person skilled in the art would recognize that the inventor had possession of the claimed invention. Section 2163 *Manual of Patent Examining Procedure* (8<sup>th</sup> Edition, August 2001).

A description as filed is presumed to be adequate unless or until sufficient evidence or reasoning to the contrary has been presented by the Examiner to rebut the presumption. Section 2163.04 *Manual of Patent Examining Procedure* (8<sup>th</sup> Edition, August 2001). The Examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. *Id.* The Examiner has the initial burden of presenting by a preponderance of the evidence why a person skilled in the art would not recognize in an applicants disclosure a description of the invention as defined by the claims. *Id.*

Applicants respectfully submit that the specification as filed is adequate and reasonably conveys to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Claim 17 of the above-identified application has been amended to refer to seed of a marigold plant of claim 13 that when grown into a marigold plant, produces a marigold plant that is capable of expressing at least one marigold plant 50011 trait selected from the group consisting of: high xanthophyll production, high flower-weight yield, male sterility and fully-double flowers. Claim 22 relates to a marigold plant produced by the method of claim 21 wherein the plant is capable of expressing at least one marigold plant 50011 trait selected from the group consisting of: high xanthophyll production, high flower-weight yield, male sterility and fully-double flowers. Claim 23 relates to seed produced from this

marigold plant. Claim 25 relates to marigold seed produced by the method of claim 24 wherein said seed is grown into a marigold plant and said marigold plant is capable of expressing at least one marigold plant 50011 trait selected from the group consisting of: high xanthophyll production, high flower-weight yield, male sterility and fully-double flowers. Claim 26 is directed to a marigold plant or its parts produced from this seed and claim 27 is directed to marigold seed produced by the marigold plant of claim 26. Claim 28 relates to a marigold plant, or its parts, where at least one ancestor of said marigold plant is the marigold plant, or its parts, of claim 13 and said marigold plant capable of expressing at least one marigold plant 50011 trait selected from the group consisting of: high xanthophyll production, high flower-weight yield, male sterility and fully-double flowers. Claim 29 relates to a marigold plant having within its pedigree marigold plant 50011, where said plant has all the morphological and physiological characteristics of marigold plant 50011. Claim 30 relates to marigold seed produced from the marigold plant of claim 29.

Applicant submits that those of ordinary skill in the art, namely plant breeders, using the specification, the sample of hybrid marigold seed 50011 deposited with the ATCC and routine techniques known in the art, can readily identify marigold plants and seed that express at least one marigold plant 50011 trait, such as, high xanthophyll production, high flower-weight yield, male sterility and fully-double flowers. Marigold plants having high xanthophyll production can be readily determined using techniques such as high performance liquid chromatography. The high flower-weight yield can be determined by cutting off the flowers of the plant and weighing. The presence of the traits of male sterility and fully-double flowers could be readily determined by visually by ordinary plant breeders.

In view of the aforementioned arguments, Applicants submit that the Examiner has not met her burden of presenting by a preponderance of the evidence that a person skilled in the art would not recognize in Applicants disclosure, a description of the invention as defined by the claims. Therefore, the rejection of claims 17, 22, 23 and 25-30 under 35 U.S.C. Section 112, first paragraph should be withdrawn.

### Claim Rejections – 35 U.S.C. Section 102/103

Claim 28 is rejected under 35 U.S.C. Section 102(b) as being anticipated by, or in the alternative, under 35 U.S.C. Section 103(a) as obvious over PanAmerican Seed (Xanthophyll Marigolds).

The publication cited by the Examiner discusses the marigold varieties 'Orangeade', 'Deep Orangeade' and 'Scarletade'. 'Orangeade' was one of the first xanthophyll varieties produced for the feed industry. 'Deep Orangeade' and 'Scarletade' are commercial improvements of 'Orangeade'. 'Deep Orangeade' has a lower flower yield than 'Orangeade', but greater than 'Scarletade'. 'Deep Orangeade' has greater xanthophyll production per hectare than 'Orangeade' due to more double flowers, but has reduced xanthophyll concentrations compared to 'Scarletade'.

Marigold plant 50011 is different from 'Orangeade', 'Deep Orangeade' and 'Scarletade' in a number of ways. First, 50011 is the first fully-double commercial xanthophyll hybrid. As shown in Table 1 on page 8 of the specification, the 50011 possesses high xanthophyll production (grams of xanthophyll per plant) and high flower-weight yield (grams of flowers per plant) when compared with 'Orangeade' and 'Scarletade'. In addition, 50011 is male sterile. 'Orangeade', 'Deep Orangeade' and 'Scarletade' are all open-pollinated varieties and are not male sterile.

Claim 28 is directed to a marigold plant or a part thereof wherein at least one ancestor of the marigold plant or part thereof is the marigold plant or part thereof of claim 13 and said marigold plant is capable of expressing at least one marigold plant 50011 trait selected from the group consisting of: high xanthophyll production, male sterility and fully-double flowers. Plants that are the subject of this claim are not anticipated or obvious in view of the Xanthophyll Publication because this publication does not disclose or suggest marigold plant 50011. Claim 28 requires that the marigold plant or part thereof has at least one ancestor that is the marigold plant 50011. In addition, claim 28 requires that the plant or part thereof exhibit at least one marigold 50011 trait such as high xanthophyll production, male sterility or fully-double flowers. These traits are not

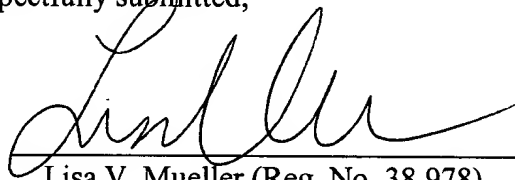
disclosed or suggested in the Xanthophyll Publication. In view of these arguments, Applicant submits that this rejection should be withdrawn.

In view of the aforementioned amendments and arguments, Applicant submits that the claims are in connection for allowance.

If any additional fees are incurred as the result of the filing of this paper, authorization is given to charge deposit account number 23-0785.

Respectfully submitted,

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**CERTIFICATE OF MAILING**

I hereby certify that this Amendment is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Commissioner for Patents, Washington D.C., 20231 on March 27, 2003.

